REMARKS:

Regarding the interview that occurred on March 11, 2004:

The undersigned wishes to note that Michelle Larson, Esq. conducted an interview with Examiners Shih and Kazimi of record regarding this application on March 11, 2004. During such interview, the Examiners agreed that Applicant's representative had pointed out distinctions over the art. Additionally, Examiner Kazimi reviewed a draft of the proposed response which was filed, and responded favorably to the amendments made. At the interview, the Examiners indicated that they wished to do more searching and agreed to contact Applicant's representatives if, after further searching, it appeared that additional rejections on new art would be forthcoming in order to attempt to resolve any issues in advance. The Examiners further agreed not make a next substantive action final. This was documented in the summary filed October 4, 2004 by Applicant in response to the present Examiner's indication that the amendment was non-responsive. Despite these agreements, 1) no new art has been cited; 2) Applicant's representatives were not contacted prior to issuance of an office action; 3) the current rejection has been made final; and 4) the issues being raised as reasons for rejection appear similar to those that were appeared to have been overcome during the interview and subsequent telephone conversations with Examiner Kazimi. The most recent amendments presented were made in the good faith belief that they were fully responsive to all of the Examiners' concerns and would result in allowance in the absence of new art.

In view of the above, Applicant submits that a new rejection is unwarranted and inconsistent with earlier agreement and that the finality of the action is improper. It is further submitted that inconsistent positions on the part of the Patent Office does not serve the public good, but rather is detrimental and unnecessarily costly to Applicants.

Regarding the rejections:

The Office Action's indication that arguments are not persuasive:

The Office Action, at paragraph 6, indicates that Applicant's arguments are not persuasive, and cites as the reason for this that "the presence of transactions as shown in the prior art inherently includes the verification of the existence of a transaction per se." While this may in fact be the case in the cited references, it is

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NOT the case with Applicant's invention as claimed. This is a significant distinction that requires careful consideration, as follows:

Detection of a transaction in Applicant's invention as claimed <u>does not</u> inherently include verification of the existence of a transaction! <u>In Applicant's invention, detection of what appears to be a transaction, may in fact not be a transaction</u>, and thus a verification process is used to assure that an instance of a transaction has in fact been detected. This is a clear distinction from a point of sale type device such as that of Wong which may have no need for a separate verification. (For example, in Wong's POS device, swiping a credit card is most certainly for the purposes of conducting a transaction. Thus, in Wong, where a credit card reader serves no purpose other than registering a transaction, the Examiner's conclusion might be reasonable – but not in Applicant's case.)

Consider for example claim 1, which claim calls for *"recognizing instances of the credit card transaction in the entries made on the personal computing device by recognition of a credit card number in the entries"*. Since there might be any number of reasons that a person might enter a credit card number at a personal computer (for example, checking an account balance, or making a list of credit card numbers, or writing a letter to a credit card company, preparing an online tax return, etc.) other than making a transaction, <u>there is no certainty that a transaction is being carried out</u>. Thus, Applicant's claims require a <u>separate</u> verification process to be carried out that confirms the instance of a credit card transaction (in order to distinguish a transaction from any other entry of a number that is or appears to be a credit card number). (Also bear in mind that the recognizing is taking place in a background process.) Again in claim 1 for example, this is called out as *"recognizing an instance of a credit card transaction <u>and</u> receiving verification of the instance of the credit card transaction"*. No such feature is taught or suggested in the cited art.

If "the presence of transactions as shown in the prior art inherently includes verification of the transaction per se" in the prior art as asserted by the Office Action, this is strong evidence that there is in fact <u>no suggestion</u> to modify the cited references to provide verification. (See MPEP 2143.01) This assertion begs the question "why is it obvious to modify the references to add a verification function that is already inherent?" The only reasonable answer is that it is not obvious. In order to establish *prima facie* obviousness, MPEP 2143.01 states in part that "the test for

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obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. If a transaction itself in the combined references inherently verifies the existence of a transaction, clearly there is no suggestion to add a separate verification operation. Reconsideration and allowance is respectfully requested.

It is further noted that the plain meaning of word "verify" requires more than "inherent existence" as proposed by the Examiner. For example, Webster's New Universal Unabridged Dictionary, deluxe second edition, defines "verify" (in relevant parts) as "to prove to be true...to confirm...to test or check the accuracy or correctness of ..." (emphasis added). Clearly the plain language meaning of the claim language requires more than "inherent existence" as proposed by the Examiner — it requires a verification operation, which the Office Action appears to disregard as a meaningful claim limitation. Applicant finds nothing that would suggest such "inherent existence" as a viable definition for the word "verify" in the art, Applicant's specification or in the dictionary. Accordingly, the Examiner's definition is based on a hindsight construction designed to support a rejection. The only stated reason for not being persuaded by the prior arguments simply cannot be considered viable, and Applicant is entitled to a patent. Reconsideration and allowance is respectfully requested.

The Office Action's reasons for rejections:

In addition to the above, the Office Action asserts that Wong discloses foreground and background processes as claimed and indicates that this is disclosed in the abstract, col.1, lines 22-30 and col. 2 lines 10-15. While multiple functions of the POS terminal are described at these locations, there is absolutely no teaching or suggestion of the foreground and background processes as claimed. The reference simply does not teach or suggest these claim limitations. Reconsideration is respectfully requested.

The Office Action further asserts that Wong discloses "recognizing an instance of a credit card transaction and automatically populating ....". Applicant notes that, for example claim 1, requires "recognizing an instance of a credit card transaction and receiving verification of the instance of the credit card transaction" (emphasis added). As noted above, no such verification is provided in Wong. The

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claim limitation cannot be ignored if a proper case of *prima facia* obviousness is to be established. Reconsideration is respectfully requested.

The Office Action further asserts that Wong discloses "upon recognizing an instance of a credit card transaction, asking a user to verify confirm storage of information describing the credit card transaction in the database" and asserts that this is disclosed at col. 12, lines 54-67. The cited disclosure simply does not provide any such teaching. Nor is there any teaching or suggestion to be found of verifying an instance of a credit card transaction consistent with the claim language as explained above. Reconsideration and allowance is respectfully requested.

Concluding remarks

Applicant wishes to reiterate the following points that were discussed during the interview noted above, and requests full consideration of these points that have already been explained in prior responses and during the interview:

- Verification is of the instance of a transaction, not of a data point associated with a transaction.
- Wong relates to a dedicated POS terminal which can only carry out transactions. This teaches away from need to verify the existence of a transaction.
- Both Wong and Boesch use remote storage of data in a database. Thus, the user loses control over the data and control is in the hands of the service provider. Certain embodiments consistent with the current invention as claimed utilize a local database that permits the user to maintain control over access to the data.
- Boesch has a stated objective of removing software from the customer's computer in favor of use of a customer information center (CIS) – thus teaching away from a system such as Applicant's where the data are stored locally and are under the control of the user.
- Neither reference teaches nor suggests detection of a credit card number appearing in a foreground process by use of a background process, both running on the same general purpose machine, and then verifying an instance of a transaction as discussed above.

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The undersigned notes that many other distinctions exist between the cited reference and the invention as originally claimed and as amended. However, in view of the clear distinctions pointed out above, further discussion of these distinctions is believed to be clearly unnecessary. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position. All claims cancelled in this response are exclusively the result of the final restriction requirement.

The undersigned respectfully requests an interview with the Examiner in the event all claims are not found allowable in view of the present response, in order to avoid the necessity of appeal or petition. The undersigned can be reached at the telephone number below.

Respectfully submitted,

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